



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/478,263 01/05/00 JARRELL

K

EXAMINER

HM12/0622

CHOATE HALL & STEWART
EXCHANGE PLACE
53 STATE STREET
BOSTON MA 02109-2891

CELSA, R

ART UNIT

PAPER NUMBER

1627

DATE MAILED:

06/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

File Copy

Office Action Summary

Application No.
09/478,263

Applicant(s)
Jarrel et al.

Examiner
Bennett Celsa

Art Unit
1627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 _____ is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-4 _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Art Unit: 1627

DETAILED ACTION

Claims 1-4 are currently pending.

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3, drawn to “combinatorial biosyntheses of compounds”, classified in many different classes and subclasses upon election of the particulars of the method (e.g. final product, reagents and types of modification) including class 435, subclass 4+.
 - II. Claim 4, drawn to “combinatorial biosyntheses of compounds”, classified in many different classes and subclasses upon election of the particulars of the method (e.g. final product, reagents and types of modification) including class 435, subclass 4+.
2. The inventions are distinct, each from the other because of the following reasons:
3. The methods of Group I and II are independent and/or patentably distinct since they have different method steps (e.g. enzymatic modification in liquid phase vs. in solid phase) which require different reagents and means of separation and purification and which would result in different final products. Additionally, due to these difference the search required for group I would be different and separately burdensome due to different manual and/or computer bibliographic and/or structure searches.

Art Unit: 1627

4. Because these inventions are distinct for the reasons given above and
- a. have acquired a separate status in the art as shown by their different classification;
 - b. require different and separately burdensome manual and computer bibliographic, structure and classification searches. search required for Group is not required for Group; and
 - c. because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

UPON THE ELECTION of the following groups, election of species is hereby required:

ELECTION OF SPECIES (GROUP I OR II)

5. Claims 1 (GROUP I) and 4 (GROUP II) are generic to a plurality of disclosed patentably distinct species comprising :
- a. "COMPOUNDS" (final product);
 - b. "STARTER UNIT"
 - c. "FUNCTIONAL HANDLE"
 - d. "TEMPLATE STRUCTURES"
 - e. "BIOSYNTHETIC ENZYMATIC MACHINERY SYSTEMS"
 - f. "FUNCTIONALIZING"

The presently claimed invention (e.g. both Groups I and II) are drawn to methods which lack any recitation of compound structure regarding the starting product, the linker, the enzyme system of the type of derivation (e.g. functionalizing) as to permit a meaningful search of the presently claimed methods.

Art Unit: 1627

Additionally, the recitation of "functional language" with regard to the items a, b, c, d with a total lack of any core structure whatsoever which would elicit a common activity (e.g improper markush) would necessarily lead to the inclusion of compound of such diverse structure, function which would render search thereof overly burdensome.

Further, there is no limit as to enzyme structure and/or function and the "functionalizing" step would further encompass any modification.

Accordingly, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, e.g. a specific compound corresponding to items a.-d. Above, a single enzyme species corresponding to e. above and a single type of functionalization corresponding to f. above even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Art Unit: 1627

General information regarding further correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Celsa whose telephone number is (703) 305-7556.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat (art unit 1627), can be reached at (703)308-0570.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Bennett Celsa (art unit 1627)

June 21, 2001

**BENNETT CELSA
PRIMARY EXAMINER**


